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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,456	01/29/1999	STEVEN W. LUNDBERG	684.002US1	7349
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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/240,456

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Ella Colbert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/13/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 are pending in this communication filed 11/10/05 entered as Response After Non-Final Action.
2. The IDS filed 10/13/05 has been reviewed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant's Specification does not appear to be in agreement with Applicant's claim limitations. In particular, Applicant's Specification discusses three computer systems: a firm computer system, a fee computer system, and an accounting computer system and then continues by discussing the printing of a check on a printer coupled to a workstation and goes on about a check. Nothing in Applicant's claim limitations have a firm computer system or a fee computer system or a check being printed. Applicant is respectfully requested to point out where the claim limitations to claims 1-16 are found in Applicant's disclosure (Specification).

Claim Rejections - 35 USC § 112

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in Applicant's claims why the client account is being replenished and why the bill is being paid twice

. Doesn't a client have to replenish his or her own account?

Please find attached to this Office Action a diagram of the interpretation of claim 1 which is very confusing to the Examiner if this is what the invention is in claim 1.

In the first claim limitation, is the computer system the firm computer system?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,070,150) Remington et al, hereafter Remington in view of (W0 96/10235) Brown.

As to claim 1, Remington teaches, a computer-implemented method for managing patent and trademark fees comprising: inputting identification information for a patent or trademark matter of a client of a law firm (i.e. customer) and a requested fee associated with the matter for payment to an agency as data representing the

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identification information into a computer system. The exchange of information may include identifying information relating to the consumer relating to the products or services being purchased) (col. 1, lines 36-45 and lines 64-67 and col. 2, lines 1-5); deducting a charge for the requested fee against a client account maintained at least in part by an organization separate from the law firm for the client, the client account initially funded by the client such that the client account has a positive balance (col. 1, lines 25-35); the organization generating a fee invoice to the law firm for the requested fee and transmitting the fee invoice to an accounting computer system used by the law firm (col. 3, lines 9-22 and lines 62-67 and col. 4, lines 1-14 and lines 57-65); and replenishing the client account with funds collected from payment of the client invoice for the requested fee (col. 7, lines 61-67 and col. 8, lines 1-6). It is well known that once a client (customer) account is debited the client (customer) has to add more money to the account to maintain a positive balance in order to avoid extra fees.

Remington failed to teach, generating a client invoice from the accounting computer system including a charge to the client for payment of the requested fee, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice corresponds to the fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account. Brown teaches, generating a client invoice from the accounting computer system including a charge to the client for payment of the requested fee, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice corresponds to the

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fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account (Page 7, lines 4-25 and Fig. 2 (100)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the processing of patent and trademark fees and to modify in Remington because such a modification would allow Remington to have a system for the use of transacting patent and trademark business with the Patent and Trademark Office.

The Examiner takes official notice that it is well known in the art of bill paying and fee collection to replenish the account so that upon payment by the customer the account continually retains a positive balance. This allows for the account to not be charge additional fees or charges and to maintain a balance of equality of a control account in the general ledger (e.g. accounts receivable) and the total balance of all accounts in the subsidiary ledger (e.g. customer accounts).

As to claim 2, Remington teaches, receiving notice of an event for the matter of the client of the firm that will require a second fee associated with the matter for payment to the agency by a due date (a remitting agreement usually contains a date when the payment is due from the customer) (col. 9, lines 39-58) and generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee (col. 10, lines 3-15).

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As to claim 3, Remington teaches, wherein the charge included on the second client invoice for the requested fee is less than the requested fee, the account having a positive balance less than the requested fee (col. 13, lines 21-67 and col. 14, lines 1-35). It is well known in the art of billing and fee collection to have the charge included on the second invoice (bill) for the requested fee to be less than the requested fee with the account having a positive balance less than the requested fee. The purpose of the second invoice (bill) for the requested fee to be less than the original requested fee would only be obvious that if the bill were for a lesser requested fee than the originally requested fee the account would have a positive balance since the originally requested fee is less than the balance in the account.

As to claim 4, Remington teaches, wherein generating the second client invoice comprises generating the second client invoice at an accounting computer system of the firm (col. 15, lines 1-17).

As to claim 5, Remington teaches, generating the charge for the requested fee at a fee computer system of the organization (col. 14, lines 36-57); transmitting data regarding the charge from the fee computer system to an accounting computer system of the firm (col. 15, lines 42-56); and generating the second client invoice at the accounting computer system (col. 16, lines 44-61).

As to claim 6, Remington teaches, wherein receiving notice of the event at an accounting computer system of the firm (col. 11, lines 6-46) and transmitting data regarding the event from the accounting computer system to a fee computer system of the organization (col. 13, lines 33-59).

As per claim 7, Remington teaches, further comprising tracking a payment made by the client as covering one of an already made charge for a requested fee associated with a matter for payment to the agency and a charge to be made for a requested fee associated with a matter for payment to the agency (col. 13, lines 60-67 and col. 14, lines 1-35).

As per claim 8, Remington teaches, further comprising issuing a refund to the client for regular payment made thereby for charges to be made requested fees associated with a matter for payment to the agency (col. 14, lines 36-57). It is well known in the art to issue a refund to the client for regular payment made for charges to be made to requested fees associated with a payment to an agency. The purpose of the refund to the customer for regular payment for charged for the requested fees is when an over payment is made or when the customer paid the bill in a timely manner.

As per claim 9, Remington teaches, wherein payment made by the client comprises a charging of one of a credit card and a charge card of the client (col. 2, lines 45-67).

As per claim 10, Remington teaches, wherein the charging is automatic (col. 3, lines 54-56, col. 4, lines 66-67, and col. 5, lines 1-10).

As per claim 11, Remington teaches, wherein the one of the credit card and the charge card comprises one of a Visa card, a MasterCard card, an American Express card, an Optima card and a Discover card (i. e. the customer can indicate the account by the "brand" name) (col. 5, lines 11-20).

As per claim 12, Remington teaches, wherein the one of the credit card and the charge card of the client is sponsored by the organization (col. 5, lines 18-20).

As per claims 13, Remington and Brown failed to teach, wherein the one of the credit card and the charge card of the client is issued by the organization. However, the Examiner takes Official Notice that it is well known in the art that one of the credit card and the charge card of the client is issued by the organization because if the card is sponsored by an organization it is issued by that organization. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of the credit card and the charge card of the client is issued by the organization and to incorporate in Remington because this would allow Remington to have both the credit card and the charge card being used to have the bill invoiced to the same organization that issued the cards.

As per claim 14, Remington and Brown failed to teach, computing interest on a positive balance of the client account to be paid to the client; determining whether on average the client account has a positive balance; and upon determining that on average the client account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency. However, the Examiner takes official notice that it is well known in the billing arts to compute interest on a positive balance of an account to be paid to the client, to determine whether on average the account has a positive balance, and determining that on the average the account has a positive balance, providing no cost issuance of the charge for the requested fee for transmittal to the agency are all accounting functions used in an organization in the

reconciling of accounts. It would have been obvious to one having ordinary skill in the art at the time the Applicant's invention was made to include the computerized method of claim 1, computing interest on a positive balance of the account to be paid to the client; determining whether on average the account has a positive balance; and upon determining that on average the account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency within the Remington and Brown systems for the motivation stated above, *supra*.

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,070,150) Remington et al, hereafter Remington in view of (W0 96/10235) Brown further in view of (US 5,794,221) Egendorf.

As per claim 15, Remington and Brown failed to teach, transmitting electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization; inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system; and reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system. Egendorf teaches, transmitting electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization (col. 5, lines 18-35); inputting second information regarding the charge received from an external source as data representing the second

information into the fee computer system (i.e. provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved) (col. 5, lines 35-37); and reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer (i.e. provider 2 can then send verifying information to one or both of the customer and vendor to indicate the transaction has been approved) (col. 5, lines 35-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization; input second information regarding the charge received from an external source as data representing the second information into the fee computer system; and reconcile electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system and to modify in the systems of Remington and Brown because such a modification would allow the Remington and Brown systems to have the capability to transmit information about the fee being charged from one computer to another remote computer and to reconcile the account after the charges have been received.

As per claim 16, Remington and Brown failed to teach, generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting system

maintained by the firm and generating a firm invoice including the charge at the fee computer system for delivery to the firm.

Egendorf teaches, generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting system maintained by the firm (col. 4, lines 52-67); and generating a firm invoice including the charge at the fee computer system for delivery to the firm (col. 5, lines 43-56). Remington, Brown, and Egendorf failed to teach, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. However, the Examiner takes official notice that it is well known in the art of electronic billing to have the client invoice correspond to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. The purpose is to emulate traditional billing and to provide convenient and correct billing to customers. It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 1, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice within the Remington, Brown and Egendorf systems for the motivation stated above, *supra*.

Response to Arguments

10. Applicant's arguments filed 11/10/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: The references further fail to contemplate an account maintained by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in claims 1-16 has been considered but is not persuasive. Response: It is interpreted that Remington teaches, inputting identification information for a matter of a client (customer) of a firm (organization) and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer system. The claim reads on replenishing an account. The client could have a bank account that has a positive balance and when the statement is received by the client the account can be replenished with funds to always keep a positive balance to cover the bill or invoice then the law firm (organization) can be paid. Perhaps Applicant should make it clear in the claim language that what is being claimed is a "recirculating retainer" system.

Issue no. 2: Applicant argues: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion: Applicant has not addressed the Examiner's 35 U.S.C. 112, second paragraph rejection regarding the lack of clarity in the claim language as to why the client account is being replenished and why the bill is paid twice. Doesn't a client have to replenish his or her own account? This is not understood from the claim language. In the first claim limitation, is the computer system the firm computer system? Please clarify in the claim language.

In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the Remington, Brown, and Egendorf references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is respectfully requested to particularly point out and to claim the novel feature of the invention in the independent claims. Where is this feature (recirculating retainer) claimed in claims 1-16, if that is considered the novel feature of the invention?

Applicant is respectfully requested to distinctly and particularly incorporate into the claim language of the independent claims what Applicant considers to be the inventive concept.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

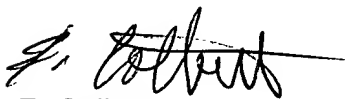
Inquiries

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
January 12, 2006